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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,819	12/26/2001	Warren S. Barham	N1261-007	4326

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JONDLE & ASSOCIATES P.C.
9085 EAST MINERAL CIRCLE
SUITE 200
CENTENNIAL, CO 80112

EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

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DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,819

Applicant(s)

BARHAM, WARREN S.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's election of Group I (claims 1-7) in Paper No. 6 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The restriction is made final. Claims 8-23 are withdrawn as being drawn to a nonelected invention.
2. The disclosure is objected to because of the following informalities: There is a blank line on pg 15, line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

It is not clear if the fruit developed in claim 1, part (b) or the fruit harvested in claim 1, part (c), is the fruit from the triploid plant, the diploid plant or both. Thus, it is not clear what fruit is being claimed in claim 2.

Claim 3 lacks antecedent basis for the limitation "said diploid short vine pollinator plant" in line 1.

Claims 4-5 lack antecedent basis for the limitation "said diploid plant" in line 1.

Claim 6 lacks antecedent basis for the limitation "said diploid ... plants" in line 1.

Claim 7 lacks antecedent basis for the limitation "said diploid plants" in line 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Elmstrom (US Patent 6,355,865, filed 26 May 1999).

Elmstrom et al teach a method of using Pollenizer 1, which has a vine diameter that is 65% less than the triploid plants (column 6, lines 53-62), to produce triploid seedless watermelon fruit, wherein Pollenizer 1 is planted every 3rd row or every 3rd, 4th or 6th plant within the same row, and wherein the fruit is harvested (column 7, lines 25-54). Elmstrom et al also teach pollenizer:triploid ratios of 1:3 (column 8, lines 13-18). This method increases the yield of the triploid seedless watermelon (column 7, lines 57-65).

7. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (1997, J. Amer Soc. Hort. Sci. 102:293-297), taken with the evidence of the instant specification.

Henderson teaches a method of producing triploid watermelon fruit by planting triploid plants and diploid short vine pollinator plants, wherein the diploid plants are Sugar Baby, which

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the instant specification teaches is a short vine plant (pg 12, §0012), and the triploid version of Sugar Baby (pg 294, left column, paragraph 3 and Tables 1 and 2). The plants were planted at a ratio of ratio of 1 diploid plant to 1 triploid plant in separate rows (pg 294, left column).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maynard et al (1992, Acta Hort. 318:169-173) in view of Crall et al (1987, Proc. Fla. State Hort. Soc. 100:251-253), taken with the evidence of the instant specification.

The claims are drawn to a method of producing triploid watermelon fruit by pollinating triploid plants with diploid short vine plants.

Maynard et al disclose a method of producing triploid watermelon fruit by pollinating triploid plants with diploid icebox watermelon varieties (pg 171, paragraph 2). Maynard et al also disclose planting at a ratio of 1 pollinator to 2 triploid plants, and planting within the same row (pg 171, paragraph 3). Maynard et al do not disclose which icebox varieties were used in the method.

Crall et al teach icebox watermelon varieties like Sugar Baby, which the instant specification teaches is a short vine plant (pg 12, §0012).

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At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the method of producing triploid watermelon fruit by pollinating triploid plants with diploid icebox watermelon varieties as taught by Maynard et al, to use Sugar Baby as described in Crall et al as the icebox watermelon variety. One of ordinary skill in the art would have been motivated to do so because the high yields and internal fruit characteristics of Sugar Baby (Crall et al, pg 252, right column, and Tables 1 and 2) would allow the grower to make a profit on selling both the triploid and diploid fruit.

Claim Rejections - 35 USC § 102 / 35 USC § 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parsons et al (1992, Seedless watermelon production, Texas Agri. Ext. Serv. Bull. L-2303, Texas A & M, College Station).

Parsons et al teach triploid watermelon fruit. The prior art triploid watermelon fruit differ from the claimed triploid watermelon fruit only by their method of manufacture. However, the claimed method of making the triploid watermelon fruit would not distinguish them over the triploid watermelon fruit taught by the prior art. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product

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produced by a different process, if the process of making the product fails to distinguish the two products.

Conclusion

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.
June 5, 2003

A handwritten signature in cursive script, appearing to read "Anne R. Kubelik", is located in the lower right quadrant of the page.